

**REMARKS**

Claims 1-28 are pending in this application. Claims 21-28 have been newly added in accordance with current Office policy, to alternatively define Applicants' disclosed invention and to assist the Examiner to expedite compact prosecution of the instant application.

The drawings have been objected to under 37 C.F.R. §1.83(a) because the Examiner alleges that some boxes of FIG. 1, FIG. 4 and FIGs. 6-7 fail to show text or labels. However, a complete review of these drawings indicates to the contrary. All boxes in FIG. 1, FIG. 4 and FIGs. 6-7 do contain either text or labels as required under 37 C.F.R. §1.83(a). As a result, withdrawal of this objection is respectfully requested.

More importantly, claims 1-20 have been rejected under 37 C.F.R. §103(a) as being unpatentable over Sweet et al., U.S. Patent No. 6,415,278, as modified to incorporate the features of Warnock, U.S. Patent No. 5,634,064 for reasons stated on pages 2-5 of the Office Action (Paper No. 5). Specifically, the Examiner alleges that Sweet '278, as a primary reference, discloses all features of Applicants' claims 1-20 substantially as claimed, except for the "print function of an operating system to transfer the selected electronic file for storage as an e-book format from the central server to the e-book server", which is allegedly disclosed on column 5, lines 51-62 of Warnock, U.S. Patent No. 5,634,064 in order to arrive at Applicants' claims 1-20. However, these allegations are technically incorrect, since neither Sweet '278 nor Warnock '064 discloses what the Examiner alleges. As a result, Applicants respectfully traverse the rejection for reasons discussed herein below.

As a preliminary matter, Applicants' disclosed invention is intended to address the problem, as identified, for example, on page 3, lines 9-12 of Applicants' disclosure:

*"there is a need an improved electronic book system for advancing distribution of electronic reading material using an electronic book (e-book) server at different locations over different data networks in order to improve data access efficiency at the e-book server using an e-book or similar viewing device"*

The solution is described in general on page 3, line 14 extending to page 4, line 12 of Applicants' disclosure as follows:

*"Accordingly, various embodiments of the present invention are directed to an improved electronic book (e-book) system for advancing distribution of electronic reading materials using an electronic book (e-book) server at different locations over different data networks. Such an electronic book system may comprise a private network; a central server connected to the private network, which stores a collection of electronic documents; an e-book server which stores an electronic document selected from the central server converted in an e-book format for later downloading to a remote e-book terminal, via a public network; and a host computer connected to the private network, which selects the electronic document from the central server, and uses a print function of an operating system to transfer the selected electronic document from the central server for storage in an e-book format at the e-book server for later downloading to a remote e-book terminal, via the public network."*

*The host computer may contain an e-book driver software and an emulation software installed therein to provide an interface with the operating system, direct the selected electronic document to the e-book server, and emulate the e-book server as a network printer in the private network. The emulation software includes a conversion subroutine for converting data reflecting the selected electronic document into an e-book format for storage at the e-book server. Both the e-book driver software and the emulation software may be embodied on any of a variety of computer readable media for use with the host computer.*

In other words, Applicants' disclosed invention relates to the distribution of electronic reading materials by introducing a dedicated e-book server that is capable of storing user selected in response of user "printing" the documents to e-book server destination for later reading.

Specifically, Applicants' base claim 1 defines an electronic book (e-book) system, comprising:

a private network;  
a central server connected to said private network, which stores a collection of electronic documents;  
an **e-book server** which stores an electronic document selected from said central server converted in an e-book format for later downloading to a **remote e-book terminal**, via a public network; and  
a **host computer** connected to said private network, which selects the electronic document from said central server, and uses a print function of an operating system to transfer the selected electronic document from said central server for storage in an e-book format at said e-book server for later downloading to said remote e-book terminal, via said public network.

Alternatively, Applicants' base claim 13 defines an electronic book (e-book) system comprising:

a private network;  
a central server connected to said private network, which stores a collection of electronic documents;  
a **docking station** connected to said private network, which supports an **e-book terminal** to receive an electronic document selected from said central server converted in an e-book format for later viewing off-line; and  
a **computer** connected to said private network, which selects the electronic document from said central server, and uses a print function of an operating system to transfer the selected electronic document from said central server in an e-book format to said docking station for downloading into said e-book terminal for later viewing off-line.

As defined in Applicants' base claims 1 and 13, electronic documents (materials) can be advantageously distributed using an e-book server (or docking station supporting an e-book terminal) at different locations over different data

networks, such as a private network and a public network, in order to improve data access efficiency at the e-book server using an e-book terminal or similar viewing device.

In contrast to the e-book system of Applicants' base claims 1 and 13, Sweet '278, as a primary reference assigned to Adobe System Incorporated, only discloses a technique of capturing hypertext (known as "HTML") web pages for convenient viewing, via an Internet. Since most visual display data on the web are stored as sets of linked HTML documents, Sweet '278 proposes that such visual display data be converted and stored as a single document, having a fixed page size, using a physical markup language such as the portable document format (PDF) as described by Adobe System. This is done by calculating minimum dimensions required to display all screen objects within the document at their normal size, creating a physical markup representation and scaling the same based on the calculations. As a result, web pages can be converted to a format having fixed page dimensions.

Specifically, in FIG. 11, Sweet '278 shows the manner in which a client software, in a form of plug-in modules or OS extensions, is installed at a user computer 100, in order to enable the user to retrieve HTML web pages from a web server 140 and convert the retrieved HTML web page(s) into a single PDF document, using a web page integrator 135, for a visual display on a monitor 140, using a PDF viewer 120.

Sweet '278 does **not** disclose or suggest anything that is remotely resemble to Applicants' claimed "electronic book system for advancing distribution of electronic reading material using an electronic book (e-book) server at different locations over different data networks (i.e., private network and public network) in order to improve

data access efficiency at the e-book server using an e-book or similar viewing device" as generally defined in each of Applicants' base claims 1 and 13.

Nevertheless, on page 3 of the Office Action (Paper No. 5), the Examiner cites element 100, FIG. 11 of Sweet '278 to correspond to Applicants' claimed "e-book server". However, this citation is misplaced. Element 100, as shown in FIG. 11 of Sweet '278 does **not** correspond to Applicants' claimed "e-book server". Rather, such an element 100, FIG. 11 of Sweet '278 corresponds to a host computer used to store the Adobe software, such as a Browser 110 used to access the web, a web page integrator 135 used to convert retrieved HTML web page(s) into a single PDF document, and a PDF viewer 120 used to allow the user to view the single PDF document on a display monitor 104.

The Examiner further cites element 140, FIG. 11 of Sweet '278 to correspond to Applicants' claimed "host computer". Again, this citation is misplaced. Element 140, as shown in FIG. 11 of Sweet '278 does **not** correspond to Applicants' claimed "host computer". Rather, such an element 140, FIG. 11 of Sweet '278 corresponds to a web server used to store web pages at a web page database 142.

Likewise, the Examiner further cites column 8, lines 24-44 of Sweet '278 to correspond to Applicants' claimed "remote e-book terminal". Again, this citation is misplaced. The cited column 8, lines 24-44 of Sweet '278 simply refers to the use of a web page integrator 135 used to convert retrieved HTML web page(s) into a single PDF document, and a PDF viewer 120 used to allow the user to view the single PDF document on a display monitor 104. No disclosure of any "remote e-book terminal" nor any conversion of a selected electronic document into an e-book format for later downloading to a remote e-book terminal is disclosed.

As a secondary reference, Warnock '064 does **not** remedy the noted deficiencies of Sweet '278 in order to arrive at Applicants' base claims 1 and 13. This is because Warnock '064 is only cited for allegedly disclosing, on column 5, lines 51-56, the feature, "print function of an operating system to transfer the selected electronic file for storage as an e-book format from the central server to the e-book server". Even then, column 5, lines 51-56 of Warnock '064 does **not** disclose what the Examiner alleges. Specifically, on column 5, lines 51-56, Warnock '064 only describes that,

"it should be noted that the PDF document 76 has the formatting and appearance of the originally created document 74 [of FIG. 3A] after the document 74 has been printed. In fact, in the present invention, the PDF article 76 is created by a printer driver accessed by the software which created the original document."

As can be seen, there is **no** disclosure of any "print function of an operating system to transfer the selected electronic file for storage as an e-book format from the central server to the e-book server" as incorrectly alleged by the Examiner.

In order to establish a *prima facie* case of obviousness under 35 U.S.C. §103, the Examiner must show that the prior art reference (or references when combined) must teach or suggest all the claim limitations, and that there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skilled in the art, to modify the reference or to combine reference teachings, provided with a reasonable expectation of success. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and **not** based on Applicants' disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP 2143. In other words, all the claim limitations must be taught or

suggested by the prior art. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). “Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination.” ACS Hospital System, Inc v. Montefiore Hospital, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). The Examiner must point to something in the prior art that suggests in some way a modification of a particular reference or a combination of references in order to arrive at Applicants’ claimed invention. Absent such a showing, the Examiner has improperly used Applicants’ disclosure as an instruction book on how to reconstruct to the prior art to arrive at Applicants’ claimed invention. Moreover, any deficiencies of the cited references cannot be remedied by general conclusions about what is “basic knowledge” or “common sense”. In re Sang Su Lee, No. 00-1158 (Fed. Cir. 2002).

In the present situation, both Sweet ‘278 and Warnock ‘064 fail to disclose and suggest all important features of Applicants’ base claims 1 and 13. Therefore, Applicants respectfully request that the rejection of Applicants’ base claims 1 and 13 and their respective dependent claims 2-12 and 14-20 be withdrawn.

Claims 2-12 and 14-20 which depend from base claims 1 and 13, are deemed patentable from base claims 1 and 13 if their base claims 1 and 13 are patentable. Hartness Int’l, Inc., v. Simplicatic Eng’g Co., 891 F.2d 1100, 1108, 2 USPQ2d 1826, 1831 (Fed. Cir. 1987); In re Abele, 684 F.2d 909, 214 USPQ 682, 689 (CCPA 1982) see also In re Sernaker, 702 F.2d 989, 991, 217 USPQ 1, 3 (Fed. Cir. 1983). Even assuming *arguendo* that independent claims 1 and 13 are not patentable under 35 U.S.C. §103, which Applicants do not believe, claims 2-12 and 14-20 are separately patentable from parent claims 1 and 13 for reasons presented herein below.

For example, dependent claims 2 and 14 further define that host computer comprises “an e-book driver software to provide an interface with said operating system and to direct the selected electronic document to said e-book server, and an emulation software to emulate said e-book server as a token network printer in said private network.” Again, this feature is neither disclosed nor suggested by Sweet ‘278 and Warnock ‘064, and the Examiner has **not** presented any evidence to the contrary.

Claims 3 and 15 further define that the e-book driver software is installed at the “host computer using an Add Printer Wizard provided by the operating system for setting up said e-book server as a token network printer in said private network to print from the operating system of said host computer.” Again, this feature is neither disclosed nor suggested by Sweet ‘278 and Warnock ‘064, and the Examiner has **not** presented any evidence to the contrary.

Claims 4 and 16 further define that the “emulation software is installed at one of said host computer and said e-book server to emulate said e-book server as a token network printer in said private network, and includes a conversion subroutine for converting data reflecting the selected electronic document into an e-book format for storage at said e-book server.” Again, this feature is neither disclosed nor suggested by Sweet ‘278 and Warnock ‘064, and the Examiner has **not** presented any evidence to the contrary.

Claims 5 and 17 further define that the “e-book driver software” and the “emulation software are embodied on any of a variety of computer readable media for use with said host computer.” Again, this feature is neither disclosed nor

suggested by Sweet '278 and Warnock '064, and the Examiner has **not** presented any evidence to the contrary.

Claim 6 and 18 further define that the "emulation software installed at said host computer emulates said e-book server as a token network printer and then converts the selected electronic document into an e-book format, via said conversion subroutine, before a physical redirection to said e-book server over said private network." Again, this feature is neither disclosed nor suggested by Sweet '278 and Warnock '064, and the Examiner has **not** presented any evidence to the contrary.

Claim 7 further defines that the "emulation software installed at said host computer emulates said e-book server as a token network printer and then converts the selected electronic document into an e-book format transferred from said host computer to said e-book server, via said conversion subroutine." Again, this feature is neither disclosed nor suggested by Sweet '278 and Warnock '064, and the Examiner has **not** presented any evidence to the contrary.

Claims 8 and 19 further define that the "e-book driver software" and the "emulation software installed at said host computer interacts with the operating system to transfer the selected electronic document to said e-book server, via said private network, according to the following steps:

activating said driver software, when a user selects said print function from the operating system;

reading, at said driver software, data reflecting the selected electronic document from a random-access-memory;

directing, at said driver software, data reflecting the selected electronic document to the operating system for a physical redirection to said e-book server, via said private network;

activating said emulation software, when said driver software returns to a stand-by (idle) mode;

receiving, at said emulation software, data reflecting the selected electronic document from said driver software, via the operating system;

converting, at said emulation software, data reflecting the selected electronic document into an e-book format and reformatting the data for said remote e-book terminal; and  
transmitting, at said emulation software, reformatted data reflecting the selected electronic document to the operating system for said physical redirection to said e-book server, via said private network.

Again, these features are neither disclosed nor suggested by Sweet '278 and Warnock '064, and the Examiner has **not** presented any evidence to the contrary.

Claim 10 further defines that the "e-book terminal for use to download or request automatic delivery of a selected electronic document stored in said e-book format at said e-book server comprises:

- an electronic module which provides a central processing unit (CPU) to control all operations of said e-book terminal under instructions of the operating system, a BIOS read-only-memory (ROM), and a random-access-memory (RAM) which provides the primary memory space to write, store and retrieve information and program instructions used by the CPU;
- a display and a display controller which support a visual display of the selected electronic document on a display screen;
- a power unit which provides power supply to said e-book terminal;
- an updatable read-only-memory (ROM) which supports additional memory capacity;
- a communication interface which supports communications with said e-book server via said public network; and
- a security unit which provides overall security to said e-book terminal.

Again, these features are neither disclosed nor suggested by Sweet '278 and Warnock '064, and the Examiner has **not** presented any evidence to the contrary.

Claims 21-28 have been newly added to alternatively define Applicants' disclosed invention over the prior art of record. These claims are believed to be allowable at least for the same reasons discussed against all the outstanding

rejections of the instant application. A fee of \$114.00 is incurred by the addition of eight (8) claims in excess of twenty.

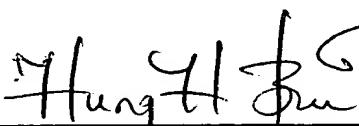
Lastly, Applicants note that none of claims 1-20 has been amended in response to the Office Action (Paper No. 5). As a result, the Examiner cannot make the next Office Action final, if the basis of the rejection is altered or changed. In view of the foregoing amendments, arguments and remarks, all claims are deemed to be allowable and this application is believed to be in condition to be passed to issue. Should any questions remain unresolved, the Examiner is requested to telephone Applicants' attorney at the Washington DC area office at (703) 312-6600.

To the extent necessary, Applicants petition for an extension of time under 37 CFR §1.136. Please charge any shortage of fees due in connection with the filing of this paper, including extension of time fees, to the Deposit Account of Antonelli, Terry, Stout & Kraus, No. 01-2135 (Application No. 0171.37310X00), and please credit any excess fees to said deposit account.

Respectfully submitted,

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